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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/051,968      | 01/16/2002  | Joseph M. Ross       | HEND-AI             | 1544             |

7590 06/28/2005

David P. Dureska  
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Canton, OH 44735-5548

EXAMINER

TO, TOAN C

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3616

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/051,968

Applicant(s)

ROSS ET AL.

Examiner

Toan C. To

Art Unit

3616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2-23-2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,3 and 11 is/are allowed.
- 6) ☒ Claim(s) 1 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

**DETAILED ACTION**

***Request for Continued Examination (RCE)***

1. The Request for continued examination filed on February 23, 2005 for a under 37 CFR 1.114 based on parent Application No. 10/051,968 is acceptable and a RCE has been established. An action on the RCE follows.

***Response to Amendment***

2. The amendment filed February 23, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "general rigid polymer" in claim 1. The specification, page 11, lines 25-26 discloses a spacer disc 30 is formed of ultrahigh molecular weight polyethylene, however, nowhere in the specification describes that "ultrahigh molecular weight polyethylene" is "general rigid polymer". For purpose of examining the claims on merit, the examiner assumes that "ultrahigh molecular weight polyethylene" is claimed in claim 1 instead of "general rigid polymer".

Applicant is required to cancel the new matter in the reply to this Office Action.

***Affidavit under 37 CFR 1.132***

3. The Affidavit under 37 CFR 1.132 filed February 23, 2005 is insufficient to overcome the rejection of claims 1 and 4 based upon Japan Publication (JP-11210794) in view of Figure 1 (Prior Art) of the present invention as set forth below because:

There is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims, and fails to set forth facts. See MPEP § 716. In this case, the Affidavit is directed to commercial success of "Glove Washer" while the claimed subject matter is directed to "spacer disk" for use in bushing assembly of the vehicle suspension. Further, the Affidavit merely discloses graphs without providing factual evidence with respect to the sale of the style washer. The graphs do not appear to reflect the influence of marketing and/or advertising. Also, the questionnaires do not provide facts. The Affidavit does not disclose how many questionnaires were sent out, how many were returned, how many contained positive information, and how many contained negative information, and so on. For these reasons, the affidavit is considered insufficient.

It fails to provide evidence of long-felt need. It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

4. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan Publication (JP-11210794) in view of Figure 1 (Prior Art) of the present invention.

Japan Publication (JP. 11210794) discloses a suspension assembly of an axle/suspension system, the assembly having a beam, said beam including a bushing assembly for pivotally mounting the beam on a vehicle frame via a frame hanger, wherein the improvement comprises: means for substantially preventing (relative movement of at least one spacer disk (rubber ring 6) disposed between the bushing assembly (5) and the frame hanger (2), wherein the spacer disk generally being prevented from movement relative to the bushing assembly, whereby excessive wear to the spacer disk moving relative to the frame hanger (2) generally is prevented.

Japan Publication (JP-11210794) discloses every element of the invention as discussed above except that the spacer apparatus is formed in one piece of ultra-high molecular weight polyethylene.

Figure 1 (Prior Art) of the present invention teaches the spacer apparatus (28) is formed in one piece of ultra-high molecular weight polyethylene in order to prevent

rattling noises from being cause by contact between the bushing and the vehicle bracket.

It would have been obvious design choice for one having ordinary skill in the art at the time the invention was made to modify bushing system of Japan Publication (JP-11210794) as taught by Figure 1 (Prior Art) of the present invention to include the spacer apparatus is formed in one piece of ultra-high molecular weight polyethylene in order to prevent rattling noises from being cause by contact between the bushing and the vehicle bracket.

#### ***Response to Arguments***

7. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that Japan Publication (JP. 11210794) does not disclose "general rigid polymer" as recited in claim 1, applicant is noted that the recitation has been objected to as being considered as new matter introduced into the disclosure.

In response to applicant's argument by way of an affidavit under 37 CFR 1.132 to rebut the rejection of claim 4 under 35U.S.C 103(a) as being unpatentable over '794 publication in view of Fig. 1 (Prior art), applicant is noted that the Affidavit is insufficient to overcome the rejection for the reasons set forth above.

#### ***Allowable Subject Matter***

8. Claim 2-3 and 11 are allowed.

**Conclusion**

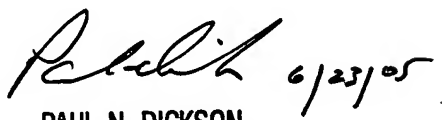
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan C. To whose telephone number is (571) 272-6677. The examiner can normally be reached on Mon-Fri (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on (571) 272-6669. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

To, T

June 20, 2005

  
PAUL N. DICKSON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600